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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,929	04/14/2006	Klaus Schultes	285437US0PCT	7074
22850	7590	02/12/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
REDDY, KARUNA P				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
02/12/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/575,929

**Applicant(s)**

SCHULTES ET AL.

**Examiner**

KARUNA P. REDDY

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 24-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-30 and 32-47 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 1/21/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 1/21/2009 has been entered. Claims 1-23 are cancelled; and claim 30 is amended. Accordingly, claims 24-47 are currently pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Double Patenting***

3. Claims 24-26, 28-31, 33-40 and 42 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6-12 of copending Application No. 11/813,946 in view of Lichtenstein et al (US 5, 621, 028).

The rejection is adequately set forth in paragraph 4 of office action mailed 6/4/2008 and is incorporated here by reference.

### ***Claim Rejections - 35 USC § 103***

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4. Claims 24-25, 30, 32, 35, 37, 39, and 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028)

The rejection is adequately set forth in paragraph 6 of office action mailed 6/4/2008 and is incorporated here by reference.

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) as applied to claim 24 above, and further in view of Parker (US 5, 252, 667).

The rejection is adequately set forth in paragraph 7 of office action mailed 6/4/2008 and is incorporated here by reference.

6. Claims 24-26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albrecht (US 4, 833, 221) in view of Suetterlin et al (US 4, 513, 118) and Lichtenstein et al (US 5, 621, 028).

The rejection is adequately set forth in paragraph 8 of office action mailed 6/4/2008 and is incorporated here by reference.

7. Claims 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) as applied to claims 32 and 35 above, and further in view of Albrecht (US 4, 833, 221).

The rejection is adequately set forth in paragraph 9 of office action mailed 6/4/2008 and is incorporated here by reference.

8. Claims 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) as applied to claim 30 above, and further in view of Suetterlin et al (US 4, 513, 118).

The rejection is adequately set forth in paragraph 10 of office action mailed 6/4/2008 and is incorporated here by reference.

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kress et al (US 4,895,898) in view of Lichtenstein et al (US 5, 621, 028) and Suetterlin et al (US 4, 513, 118) as applied to claim 38 above, and further in view of NieSsner et al (US 2001/0007890 A1).

The rejection is adequately set forth in paragraph 11 of office action mailed 6/4/2008 and is incorporated here by reference.

10. Claims 24, 26-27 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhein et al (EP 0 691 351 A1) in view of Suetterlin et al (US 4,513,118) and Lichtenstein et al (US 5, 621, 028).

The rejection is adequately set forth in paragraph 12 of office action mailed 6/4/2008 and is incorporated here by reference.

***Allowable Subject Matter***

11. Claim 31 is objected to as being dependent upon a rejected base claim 30, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, pending a filing of terminal disclaimer to overcome the

obviousness-type double patenting rejection over copending application No. 11/813,946, for the reasons presented in paragraph 13 of office action mailed 6/4/2008 and is incorporated here by reference.

### ***Response to Arguments***

12. Applicant's arguments, filed 1/21/2009, with respect to objection of claims 30-38 and 40 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, have been fully considered and are persuasive. The objection of claims 30-38 and 40 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn in view of the amendment.
13. Applicant's arguments filed 1/21/2009 have been fully considered but they are not persuasive. Specifically, applicant argues that (A) applicant's contend that "consisting essentially of" limits present claim 24 to a polymer mixture in which the matrix is one of the four components (i) to (iv). In contrast, polymer mixture disclosed in Kress et al, is a thermoplastic polycarbonate while there is no polycarbonate component in the present polymer mixture; and (B) polymer mixture in copending case is formulated of three different (meth)acrylate copolymers having specific solution viscosities, and a cross-linked poly(meth)acrylate (i.e. impact modifier); and (C) Lichtenstein et al patent is cited for its disclosure of the incorporation of plastic particles into a polymer matrix comprising at least 80% of units of methylmethacrylate and is different from one of the four components and impact modifier of present claims.

With respect to (A), as stated earlier and reiterated here - while use of transitional phrase "consisting essentially of" narrows scope of the polymer matrix to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. polycarbonate, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention. See MPEP 2111.03. Moreover, the statement "present claims do not contain fundamentally different thermoplastic polycarbonate" in applicant's invention is a conclusory statement with no evidentiary weight, i.e., attorney's statements are not a substitute for factual evidence. Case law holds that "[i]f an applicant contends that additional steps or material in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). Applicant is advised to submit clear and convincing evidence in the form of a declaration that presence of thermoplastic polycarbonate would materially affect the basic and novel characteristics of applicant's invention. In addition, the present claims are directed to a "polymer mixture" and use of transitional phrase "comprising" to describe the "polymer mixture" is open-ended and can include other component such as polycarbonate in an amount of 20-80 percent weight.

With respect to (B), applicant's attention is drawn to present claim 31 wherein it recites "one or more of the following poly(meth)acrylate components d), f) and g) and

that impact modifier b) is impact modifier e)". Furthermore, viscosity of components d), f) and g) of the present claim 31 overlaps with the viscosity of (meth)acrylate copolymers of copending application, and the impact modifier is a crosslinked poly(meth)acrylate in both applications.

With respect to (C), at the outset it is noted that applicant refers to non-combinable nature of Kress et al and Lichtenstein et al (bridging paragraph page 10-11). However, since it is included under the "obviousness-type double patenting" section, examiner understands it to mean the non-combinable nature of Copending Application No. 11/813,946 and Lichtenstein et al. Claims in copending application comprise all the components of present claims except plastic particles. After doing the Graham v. Deere analysis, Lichtenstein et al is brought in as a secondary reference to teach that polystyrene can be added as a light scattering agent to molded articles that comprise polymethyl methacrylate and thus render them translucent rather than transparent. Thus, it is clear that motivation to arrive at the combination based on claims in copending application and Lichtenstein et al is presented in paragraph 4 of office of 6/4/2008 and incorporated here by reference.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone



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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796